

REMARKS

Reconsideration of the above-identified application is respectfully requested.

The claims remaining in the application are claims 1-4, a total of 4 claims. No new fee is required. It is believed the application is in condition for allowance in view of the amendments noted above and the Remarks which follow.

It is noted with appreciation that the rejection of claim 4 under 35 U.S.C. § 112, first and second paragraphs, has been withdrawn.

Claims 2 and 3 stand rejected under 35 U.S.C. § 112 as lacking antecedent basis in using the phrase "cleaning agent" rather than "cleaning agent composition" as recited in independent claim 1 from which these claims depend. It is believed these claims do comply with 35 U.S.C. § 112 as written, however, in the interest of expediting prosecution, applicant has amended claims 2 and 3 to include the word "composition" and it is believed this amendment overcomes this ground of rejection.

Claims 1-4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 63069897A (hereinafter "JP"). Applicant had furnished an English translation of the reference and the Examiner provided an additional English translation with Paper #23. The Examiner first notes a mistake by applicant in stating erroneously in the response mailed June 18, 2001 that the reference describes in the claims at page 2 of the translation a composition containing 0.2 - 5% high boiling solvents rather than 0.2 - 50 parts by weight. Applicant is grateful for noting this error. Certainly there was no intention to mischaracterize the reference as applicant had previously furnished a translation which clearly stated the range of 0.2 - 50 parts by weight in the claims and the Examiner had properly characterized this aspect of the reference in paper #20. Any confusion applicant may have caused by this unintentional error is regretted.

The Examiner has argued that applicant's contention that the JP reference is unrelated art is unpersuasive. The Examiner has taken the position that the claims relate broadly to any "releasing agent composition" which encompasses the release of any agent from any surface. Applicant hastens to note that the claimed invention relates to a composition for removing an aqueous polymer floor polish. Thus, it is believed that the field of the invention relates to

floor polish removal. One skilled in the art would not look to the field of printed circuit board manufacture to address floor polish removal. If the art is not anticipatory and is not relevant prior art, then the additional arguments regarding intended use, etc. made by the Examiner are not appropriate. The issue of relevant prior art is not the same as the question of whether a statement of intended use limits a claim. It is a question of relevance of prior art and obviousness, not a question of claim construction.

The Examiner states that different intended uses for otherwise similar products is not a patentable distinction and the intended use must result in a structural difference. The Examiner further cites case law for the proposition that if the prior art structure is capable of performing the intended use, then it meets the claim. These arguments appear to be based on comparison to anticipatory prior art and ignores the fact that the present invention is not anticipated by the JP reference. The Examiner has recognized that the art is not anticipatory as the rejection is based on 103 rather than 102. The printed circuit board processing compositions taught by the JP reference are not "otherwise similar products" to the floor polish removal compositions claimed in the present invention. Whether the processing compositions disclosed in the JP reference could perform the intended use is not relevant in the instant case because the compositions are not the same and the statement of use is not needed to distinguish the compositions. In the present case, the claimed composition is different from any specific composition taught by the JP reference and the determination of patentability must be based solely on considerations of what would have been obvious at the time the invention was made.

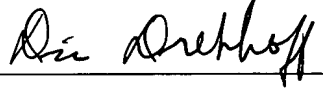
Since there is not anticipation, that brings the focus back to whether the claimed invention would have been obvious in view of the JP reference. The Examiner has stated that all the claimed components are disclosed by the JP reference in the claimed amounts (paper #23, page 4, 1st paragraph). Applicant disagrees. The disclosure of a large number of components and disclosure of a broad range of possible amounts does not show the claimed combination in the claimed amounts. The Examiner can point to no specific disclosure that supports that statement. The Examiner adds that the reference is not limited to the working examples. Applicant agrees with the general statement of the law. However, as noted above, the disclosure of the JP reference outside of the working examples is nothing more than a catalog of components and ranges that can be used in various combinations to process printed circuit boards. This is not anticipation of the presently claimed invention under the law.

Recognizing this situation the Examiner reverts to stating that "non-preferred embodiments can be indicative of obviousness". Again, applicant agrees with the general statement of the law, but disagrees that it leads to a conclusion of anticipation or obviousness with respect to proper application of the JP reference to the instantly claimed invention. The teachings beyond the working examples merely identify the ingredients used in the present invention along with others not used in the present invention. The amounts broadly disclosed overlap those of the present invention in some cases, but that is not, under the applicable law, a teaching or suggestion of the present invention for the reasons noted above; unrelated field of art and lack of specificity.

Even if the reference were deemed to be in a relevant field of the art, it teaches nothing with respect to the claimed invention. The teachings of the JP patent describe many ingredients, some of which are the claimed ingredients, and describes that they may be used in various combinations within broad, equivalent ranges for the purpose of manufacturing printed circuit boards. That simply is not foresight of the claimed invention which is based on a specific combination and amount of certain of the ingredients. The Examiner attempts to justify the application of this hindsight analysis by suggesting the proper test of what would have been obvious necessarily involves a reconstruction based upon hindsight reasoning. Again, applicant disagrees. Proper analysis of what would have been obvious after the fact is not the same as improper hindsight reasoning. Hindsight reasoning presupposes knowledge of the end result and asks whether one could achieve the result by proper selection of ingredients from the catalog of ingredients listed in the JP reference. This is not the test of obviousness. The test is what would have been obvious at the time the invention was made to a skilled worker in the art having the reference before him, but without knowledge of applicant's disclosure. Applicant submits the Examiner cannot point to anything in the reference suggesting the use of the printed circuit board manufacturing compositions as floor polish removers. Applicant submits the Examiner cannot point to anything in the reference suggesting the proper selection of the ingredients used in the printed circuit board manufacturing compositions to make them eminently suitable as floor polish removers. This absence of teaching leads to the legal conclusion that the claimed invention is not obvious.

It is believed that claims 1-4, as amended, are now in condition for allowance and early and favorable consideration is respectfully requested.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "W. Dennis Drehkoff", written over a horizontal line.

October 18, 2001

Date

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DOCKET: CU-1758



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Mitsuo SADO)
SERIAL NO: 09/117,795) Group Art Unit: 1774
FILED: August 13, 1998) Examiner: D. Garrett
TITLE: Releasant for Aqueous Polymer-Type

THE ASSISTANT COMMISSIONER FOR PATENTS
Washington, D.C. 20231

MARKED VERSION OF CLAIMS

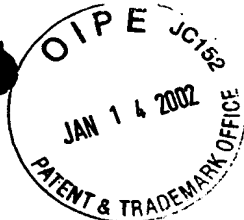
2. The releasing agent composition according to Claim 1, wherein component (A) is one member selected from the group consisting of diethylene glycol mono-n-butyl ether and triethylene glycol mono-n-butyl ether.

3. The releasing agent composition according to Claim 1, wherein component (C) is an alkanolamine.

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SERIAL NO: 09/117,795) Group Art Unit: 1774
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TITLE: Releasant for Aqueous Polymer-Type

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CLEAN VERSION OF CLAIMS

2. The releasing agent composition according to Claim 1, wherein component (A) is one member selected from the group consisting of diethylene glycol mono-n-butyl ether and triethylene glycol mono-n-butyl ether.

3. The releasing agent composition according to Claim 1, wherein component (C) is an alkanolamine.

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